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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,019	06/01/2001	Mitchell T. Berg	29820.9	3234

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EXAMINER
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LIN, KELVIN Y

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/873,019

Applicant(s)

BERG, MITCHELL T.

Examiner

Kelvin Lin

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 21-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/28/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

C.O.O.

## **Detailed Action**

### **Response to Amended Claims**

Newly submitted claims 21-35 directed to an invention that are independent or distinct from the invention originally claimed (Claims 1-20), for the following reasons:

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - A. Claims 1-20, digital processing system initialization or configuration, (e.g. initializing, set up, configuration, or resetting), classified in class 713, subclass 1.
  - B. Claims 21-35, drawn to Computer-to-computer data transfer regulating, classified in class 709, subclass 232.
2. In the instant case, invention A has an information processing system selectively initiate execution of a software by one of computing device. In the instant case, invention B has a server farm for processing client requests, comprising servers and maintain a state table associated with at least the first and second server and selectively forwarding the request packet to the second server when the state table corresponds to a second state.
3. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 21-35 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-20 are rejected under 35 USC 102(e) as being anticipated by Johnson et al., (U.S. Patent 6788980), and claims 21-35 are withdrawn from further consideration.
3. Regarding claim 1, Johnson teaches an information processing system, comprising: a first computing device configured to (Johnson, col.3, l.52-67, which the intelligent actuator corresponds to the first computing device):
  - selectively initiate execution of a software application by one of (Johnson, col.3, l.56-60, the configuration editor corresponds to the software application) :
    - a. the first computing device if a state of at least one of the first computing device and a second computing device is a first state (Johnson, col.3, l.60-67,col. 4, l. 1-3, the configuration editor will be disabled if the device is

incorporated in a network if lacks such a capacity (first state), col.6, l.21-27, contains one of more field devices); and

- b. the second computing device if the state is a second state, the software application being associable with one or more software objects (Johnson, col.3, l.60-67, col.4,l.1the configuration editor can be enabled an application development environment suitable for configuration of the device (second state), col.7, l.21-28).

- 4. Regarding claim 2, Johnson further discloses the system of claim 1 wherein the software application is a socket-based application (Johnson, col. 6, l.38-39, Java virtual machine performs the socket\_based application – Java 1.1 3<sup>rd</sup> edition, 1997).
- 5. Regarding claim 3, Johnson further discloses the system of claim 1 wherein the state is a synchronized state of at least the first and second computing devices (Johnson, col.9, l.42-63, the controller which connected to the field device, ..synchronization between stations..).
- 6. Regarding claim 4, Johnson further discloses the system of claim 1 wherein the state includes information for identifying a group of software applications executed by the first and second computing devices (Johnson, col. 12, l.6-20,the control system supports application software includes system monitor, PCOs,and other Java-based code..).

7. Regarding claim 5, Johnson further discloses the system of claim 1 wherein the state indicates whether the software application has an associated listening socket (Johnson, col.22, l.56-67, the listening process.. to receive all messages.. if the client so requests, which corresponds to the client/server socket based communication and corresponds to the sending process).
8. Regarding claim 6, Johnson further discloses the system of claim 1 wherein the software application is a first software application, and wherein the first computing device is configured to, in response to execution of the first software application and the state, selectively initiate execution of a second software application by the second computing device (Johnson, col.3, l.60-67,col.4, l.1-3, which the configuration editor is the software application and has been enabled or disabled based on the connection state of network, and they can be executed in either local or foreign device in the network).
9. Regarding claim 7, Johnson further discloses an information processing system, comprising: a first computing device configured to (Johnson, col.3, l.52-67):
  - execute a software application that is associated with at least one software object; and in response to a request for initiating execution of the software object, independent of the software application, selectively initiate execution of the software object (Johnson, col. 16, l.19-61, col.21, l.56-60, col. 22, l. 56-67 ) by one of:
  - the first computing device if a state of at least one of the first

computing device and a second computing device is a first state (Johnson, Johnson, col.3, l.60-67, col. 4, l. 1-3); and

- the second computing device if the state is a second state (Johnson, Johnson, col.3, l.60-67, col.4,l.1).

10. Regarding claim 8, Johnson further discloses the system of claim 7 wherein the software application is a socket application (Johnson, col.21, l.46,, l.60-61, Java virtual machine performs the socket application – Java 1.1 3<sup>rd</sup> edition, 1997).
11. Regarding claim 9, Johnson further discloses the system of claim 7 wherein the state is a synchronized state of at least the first and second computing device (Johnson, col.9, l.42-63, the controller which connected to the field device, ..synchronization between stations..).
12. Regarding claim 10, Johnson further discloses the system of claim 7 wherein the first computing device is for coordinating a communication of information between the software application and the software object, even if the software object is executed by the second computing device (Johnson, fig.2, controller 60, and field devices 64).
13. Claims 11-16 have similar limitation as claims 1-6. Therefore, claims 11-16 are rejected for the same reason set forth in the rejection of claims 1-6.
14. Claims 17-20 have similar limitation as claims 7-10. Therefore, claims 17-20 are rejected for the same reason set forth in the rejection of claims 7-10.

***Response to Remarks***

15. The Application's arguments with respect to claims 1-20 have been considered but are not persuasive.
16. Regarding claims 1, 7, 11, and 17, applicant argues that " Johnson does not even discuss a first computing device selectively initiating execution based upon a state as claimed".

Johnson teaches the first computing device in col3, l.52-67, which the intelligent actuator corresponds to the first computing device. In Johnson, col. 3, l.56-60, the configuration editor corresponds to the software application and an end-user can execute (initiate) via the browser and web server. In Johnson, col. 3, l.60-67, and col.4, l.1-3, the configuration editor will be disabled if the device state is incorporated in a network that lacks such a capacity (corresponds to second state), and in col. 6, l.21-27, it corresponds to select one of more field devices. Furthermore, In Johnson, col.3, l.60-61, the configuration editor can be enabled an application development environment suitable for configuration of the device (first state), col.7, l.21-28).

17. Applicant also argues that " Johnson does not suggestion that .. a first computing device to selectively initiate execution of a software application by itself or by a second computing device".

In Johnson, col.9, l.42-63, the controller connected to the field device, .. and... synchronization between stations which corresponds to the state information is



used by first or second field devices.

### ***Conclusion***

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE MONTH** shortened statutory period, then the shortened statutory period will expire on the date advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTH** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelvin Lin whose telephone number is 571-272-3898.

The examiner can normally be reached on Flexible 4/9/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharra can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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05/16/05

  
**BEATRIZ PRIETO**  
**PRIMARY EXAMINER**